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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,195	06/27/2002	Henri Samain	13833.0013	5156

7590 06/09/2005

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1330 Connecticut Avenue N W
Washington, DC 20036

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,195

Applicant(s)

SAMAIN ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 to 16, 18 to 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12 to 16, 18 to 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Upon reconsideration, the Examiner has opted to make a new ground of rejection in the form of a 35 USC 112 rejection, as noted below. The Examiner apologizes for not making this rejection in the previous office action. As such, this action cannot be made final.
3. Claims 12 to 16, 18 to 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "cosmetic effect" is indefinite since one cannot determine what is and is not embraced by this term. For instance, the specific effects found in claim 14 and for compound (I) in claim 12 are clear with the exception of "reducing effect". It is unclear what this means and thus, reading the phrase "cosmetic effect" in light of the specification, one cannot determine the breadth of these claims.

4. Claims 12 to 16, 19 to 22 are rejected under 35 U.S.C. 102(e) or, in the alternative, under 35 USC 103(a) as obvious over Liebskind et al.

This rejection relies on the rationale of record, and as such this will not be repeated. Applicants have amended claim 12 to require that the cosmetic effect be coloring, UV stabilizing, antifungal or reducing. However the cationic amine found in Liebskind et al. will inherently have a antifungal effect. While this property is not specifically taught by Liebskind et al. they do clearly suggest it by mentioning on column 12, lines 35 to 40, antimold effects. Note that mold is a type of fungus. On the other hand, the prior art need not recognize an inherent property in the composition to render claims unpatentable. The fact that the composition will inherently meet this limitation is sufficient.

To support the Examiner's position of inherency, she also cites 5,281,240 and 5,319,049. She notes that these references need not be included in the basis for the

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rejection as they are cited to support a position of inherency for a property that will necessarily be in the prior art composition.

See column 3, lines 20 to 60, of '049 which teaches that ammonium groups such as that in Liebskind et al. provide antifungal and mildewproofing properties. See also column 3, lines 30 to 64, of '240 which teach that an ammonium silane is effective against fungi.

Thus, while not specifically taught, the ammonium group in Liebskind et al. would have been expected to inherently possess antifungal properties and thus meets the limitation in claim 12. The remaining claims are met by Liebskind et al. for reasons of record.

With regard to claims 19 to 21, note that the rejection applies to these claims because they fail to limit the cosmetic effect of the silane compound. They depend upon claim 14 which further limits the siloxane.

With regard to claim 22, note that the phrase "hair product ingredients" is quite broad and that the composition in Liebskind et al. contains various components which can also be found in a hair product. See for instance the stabilizers on column 27, the dyes suggested on column 34, lines 51 to 63, and the surfactants and detergents on column 34, line 37.

5. Claim 18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. As noted in the previous office action, the prior art fails to teach or suggest such a disiloxane.

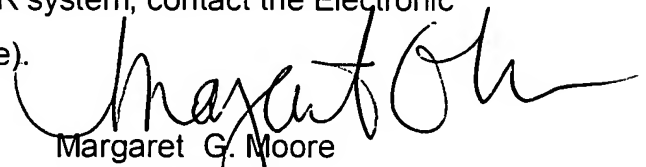
6. Claim 23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The prior art fails to teach or suggest the addition of hair products ingredients for holding or shaping hair. The general teaching of cosmetics on column 33 is inadequate to render obvious such additional ingredients.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
5/20/05